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Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-6,8 in the reply filed on 5-7-08 is acknowledged.

Claim Rejections - 35 USC § 102 and 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6,8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lupton et al (6,030,507).

Lupton et al teach an ITO powder including 9.6 wt% Sn (column 4, lines 60-62).

A $\text{In}_4\text{Sn}_3\text{O}_{12}$ is not taught therefor would not considered to be present.

It is well settled that when a claimed composition appears to be substantially the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Swinehart, 439 F.2d 2109, 169 USPQ 226 (CCPA 1971).

In product-by-process claims, "once a product appearing to be substantially identical is found and a 35 U.S.C. 102/103 rejection [is] made, the burden shifts to the applicant to show an unobvious difference." MPEP 2113. This rejection under 35

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U.S.C. 102/103 is proper because the "patentability of a product does not depend on its method of production." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

5. Claims 1-6,8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Goy et al (5,762,768).

Goy et al teach an ITO powder having a indium oxide to tin oxide ratio of 90:10 (column 2, lines 59-64). A $\text{In}_4\text{Sn}_3\text{O}_{12}$ is not taught therefor would not considered to be present.

It is well settled that when a claimed composition appears to be substantially the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); *In re Swinehart*, 439 F.2d 2109, 169 USPQ 226 (CCPA 1971).

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6. Claims 1-6,8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Japanese document 11011946.

The Japanese document 11011946 teaches an ITO powder including 90 volume % indium, see abstract. A $\text{In}_4\text{Sn}_3\text{O}_{12}$ is not taught therefor would not considered to be present.

It is well settled that when a claimed composition appears to be substantially the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); *In re Swinehart*, 439 F.2d 2109, 169 USPQ 226 (CCPA 1971).

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7. Claims 1-6,8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Japanese document 63-199862.

The Japanese document 63-199862 teaches an ITO powder including 7.5wt% tin (page 3, second column), see abstract. A $\text{In}_4\text{Sn}_3\text{O}_{12}$ is not taught therefor would not considered to be present.

It is well settled that when a claimed composition appears to be substantially the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); *In re Swinehart*, 439 F.2d 2109, 169 USPQ 226 (CCPA 1971).

In product-by-process claims, "once a product appearing to be substantially identical is found and a 35 U.S.C. 102/103 rejection [is] made, the burden shifts to the applicant to show an unobvious difference." MPEP 2113. This rejection under 35 U.S.C. 102/103 is proper because the "patentability of a product does not depend on its method of production." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl E. Group whose telephone number is 571-272-1368. The examiner can normally be reached on M-F (6:30-4:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Karl E Group/
Primary Examiner
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Keg
6-5-08